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10/002,217	11/01/2001	Craig Nemecek	CPPR-CD01207M	1780

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WAGNER, MURABITO & HAO LLP  
Third Floor  
Two North Market Street  
San Jose, CA 95113

EXAMINER
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PROCTOR, JASON SCOTT

ART UNIT	PAPER NUMBER
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2123

MAIL DATE	DELIVERY MODE
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02/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/002,217

Applicant(s)

NEMECEK, CRAIG

Examiner

Jason Proctor

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/7/08.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-20 were rejected in the Office Action entered on 3 August 2007.

Applicants' submission on 7 January 2008 has amended claims 1, 6, and 14. Claims 1-20 are pending in this application.

Claims 1-20 are rejected.

#### ***Information Disclosure Statement***

1. The information disclosure statement filed 7 January 2008 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The Information Disclosure Statement claims that "copies of publications listed on Form PTO-1449 from prior application Serial No. 09/975,105 filed on October 10, 2001, of which this application claims priority under 35 U.S.C. § 120, are not being submitted pursuant to 37 CFR § 1.98(d). The Examiner has considered every such publication that can be located in the parent '105 application. However, publications listed as X2-Y2, C3-V3, and A4-F4 are not found in this application or the '105 application. Accordingly, these references have not been considered by the Examiner.

Further, references W3-Z3 identify US Patent applications which are not publications suitable for printing on the front page of a patent, should a patent issue from the instant

application. The Examiner has considered and initialed these references, but has lined through them so that they will not be printed on any patent.

***Applicants' Remarks - Priority***

2. In response to the "Priority" section found in four of the five previous Office Actions, Applicants submit that:

Applicant respectfully submits that the proper test for priority is whether the claims in a U.S. application are entitled to the benefit of a provisional application (cit. omitted) and not whether the specification, e.g., Figure 7, finds support as seems to be alleged by the rejection. Thus, Applicant respectfully submits that alleging what may or may not be disclosed in the provisional application regarding Figure 7 can result in discrepancies in the priority determination when such an (incorrect) test is used.

The Examiner responds as follows.

The claimed invention is not described in the provisional application in accordance with 35 U.S.C. § 112. Applicants' arguments have been fully considered but have been found unpersuasive.

***Priority***

3. This Application contains a claim for the benefit of priority to U.S. Provisional Application No. 60/243,708 filed 26 October 2000. The provisional application has been reviewed and priority is denied, because the provisional application does not appear to enable the claimed invention as required under 35 U.S.C. Section 112, first paragraph. See 35 U.S.C. § 119(e)(1).

For example, the provisional application contains a set of 'powerpoint-style' drawings and datasheets describing desired features for a microcontroller or a 'system-on-chip,' but this

material does not appear to contain either the text description or the drawings found in the Application. In particular, no part of the provisional application appears to disclose the method steps shown in the Application at Fig. 7.

***Response to Arguments – Claim Objections***

4. In response to the previous objection to claims 1-20 for confusing the terms "I/O read data" and "I/O read instruction," Applicants argue primarily that:

Claim 1 recites that the I/O read data is followed by a conditional jump instruction, as claimed which is mirrored in the detailed description by stating that "the instruction following the I/O read is a conditional jump". Thus, withdrawal of the objection is earnestly requested.

The Examiner respectfully traverses this argument as follows.

An "I/O read" is an **instruction** and is **separate and distinct from I/O read data**. An I/O read instruction **operates on** I/O read data, and is not the same thing as I/O read data.

The portion of Applicants' specification quoted in Applicants' remarks describes that "the instruction following the I/O read is a conditional jump." Applicants' specification describes **one instruction** (I/O read) followed by a **second instruction** (conditional jump).

In clear contrast to the specification, the independent claims recite "said microcontroller sends **I/O read data** to a virtual microcontroller, wherein said **I/O read data is followed by a conditional jump instruction.**" Applicants' have confused the terminology "I/O read instruction" and "I/O read data".

Applicants' arguments have been fully considered but have been found unpersuasive.

***Claim Objections***

5. The previous objection to claims 1-5 for ambiguously referring to multiple “virtual microcontrollers” is withdrawn in response to the 7 January 2008 amendments.

6. The previous objection to claims 1-20 related to the language "executing the same instruction using the same clocking signal" is withdrawn in response to the 7 January 2008 amendments.

7. Claims 1-20 are objected to because of the following informalities: The claim language appears to confuse the term “I/O read data” and “I/O read data *instruction*”. For example, claim 1 recites “wherein said I/O read data is followed by a conditional jump instruction,” however the disclosure of the invention is directed to an I/O read *instruction* (or “I/O read”) followed by a conditional jump instruction that depends on the result of the I/O read (see FIG. 8; specification page 26, lines 17-24; etc.). Appropriate correction or clarification is required.

***Response to Arguments – 35 USC § 112***

8. In response to the previous rejections of claims 1-20 under 35 U.S.C. § 112, first and second paragraphs, as failing to comply with the written description requirement, Applicants argue primarily that:

Applicant respectfully submits that the rejection improperly substitutes a misunderstanding of the recited claim limitation for what is actually claimed.

[...] Nowhere does the claim recite that the conditional jump instruction is sent, as alleged by the rejection. Independent claims merely recite that the I/O read data is sent from the microcontroller to the virtual microcontroller, and that the I/O read data is followed by a conditional jump. Thus, Applicant respectfully disagrees with the rejection’s rationale because it is clear what is being sent and what is not being sent.

However, in the interest of expediting prosecution of this case, Applicant has amended independent claim 1, 6, and 14 to further clarify what is being sent and what is not being sent.

The Examiner responds to this argument as follows.

The previous rejection was based upon the **explicitly recited language of the claims** which plainly recited that a "microcontroller sends I/O read data ... and wherein I/O read data is followed by a conditional jump instruction." Thus, there was no misunderstanding on the part of the Examiner regarding what was claimed. Further, the Examiner clearly understood that the claim language was inconsistent with the disclosed invention as shown by the previous rejection for lacking written description.

Applicants' amendments to the claim language are noted.

The previous rejections under 35 U.S.C. § 112, first and second paragraph, are withdrawn in response to Applicants' amendments to the claim language.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 6, and 14 recite the following or similar language which renders the invention vague and indefinite:

A microcontroller, wherein said microcontroller sends I/O read data to a virtual microcontroller, and wherein said I/O read data is followed by a conditional jump instruction that resides on said virtual microcontroller

This claim language defines that an entity (said microcontroller) *sends* something (I/O read data) which is *followed* by something (conditional jump instruction) that exists at the destination (virtual microcontroller).

By analogy, this language is similar to sending a piece of mail to the post office, wherein said piece of mail is followed by a package that is already located at the post office.

This limitation is vague and indefinite. The scope of the claimed subject matter cannot be ascertained from the claim language. As noted above in the claim objections, Applicants appear to be confusing the terms "I/O read instruction" and "I/O read data".

As a result of the persistent deficiencies regarding the claimed description of the "microcontroller" in each of the independent claims, the Examiner is unable to determine the scope of patent protection sought by Applicants.

Claims rejected but not specifically mentioned stand rejected by virtue of their dependence.



***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Proctor whose telephone number is (571) 272-3713. The examiner can normally be reached on 8:30 am-4:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached at (571) 272-3753. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR)

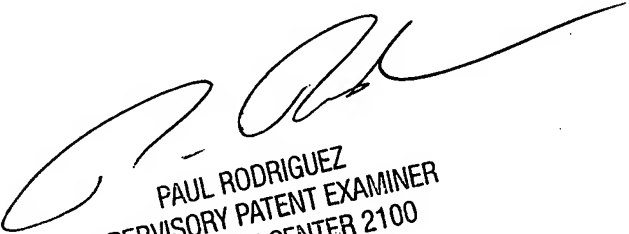
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system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Proctor  
Examiner  
Art Unit 2123

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PAUL RODRIGUEZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100